

## **REMARKS/ARGUMENTS**

This is in response to the official action dated June 23, 2008. Reconsideration is respectfully requested.

### **Amendments to the Drawings:**

The Examiner objected to the drawings. He pointed out that reference numerals 21-31 were not shown in the drawings, especially items [24], [26], [23] and [30]. Upon review of the file, applicant submits that all such objected to items are shown in Fig. 2. Upon further review of the PTO Website, under the application number of the present case, Applicant observed that in the Image File Wrapper, Fig. 1 was imaged twice and Fig. 2 is not imaged at all. However, reviewing other submissions made on December 20, 2005, the day on which the present application entered National Stage as a 371 Application, the Publication of the underlying International Application, WO 2004/112623 was also submitted. Applicant points to a 15 page submission identified as "Documents submitted with 371 Application". Page 15 of such documents also shows Fig. 2. Thus, submitting herewith Fig. 2 as a "New Sheet" is not to be considered new matter, but merely corrects what is believed to be a PTO imaging error. (Imaging Fig.1 twice, instead of Fig. 1 and Fig. 2, each one time).

Upon review of Fig. 2, it will be clear to the Examiner that all numerals 21-31 are shown.

### **Claim rejections under 35 USC § 102**

The Examiner rejected claims 8 and 11 as being anticipated by Yoder et al. (US 5,871,462). Applicant amended independent claim 8 to further emphasize differences between Yoder and the present invention and submits that claims 8 and 11 cover a different water jet apparatus assembly than the one taught by Yoder. Yoder discloses a system for generating a high pressure fluid jet including a variable pressure pump for creating the high pressure fluid and a burst resistant delivery tube for safely conducting the pressurized stream. The pump includes a disposable diaphragm pump which is driven by a reusable pump, such as a piston pump or an air intensifier unit. The pumped fluid communicates only with the disposable diaphragm component, allowing contamination free reuse of the system by replacing a spent diaphragm unit with a fresh, sterile

disposable pump. A hand-held wand is connected by a single delivery tube to the diaphragm pump. The wand has orifices for creating a fluid jet. The disposable diaphragm pump is mounted to a reusable pumping chamber which generates the force required to flex the diaphragm to fill and eject fluid from a pumping chamber. In contrast, Applicant provides a different and enhanced water jet apparatus, which differs in several ways. For one, Applicant implements an entirely different pump system, that is, one that creates *a suction space* and *a pressure space* by utilizing *a piston system*. The details of the piston-pump are included in claim 8, in that

“a cylinder formed in a cylinder casing and the cylinder having a wall and a bottom, a piston received in the cylinder casing for reciprocal motion of the piston in the cylinder with space remaining adjacent the bottom of the cylinder, the space functioning as a pressure space upon downstroke of the piston and as a suction space upon upstroke of the piston, and an annular membrane having an inside periphery attached to the cylinder wall at a position in an upper zone of the piston-cylinder unit and an outside periphery attached to the piston at a position in the upper zone of the piston-cylinder unit, the upper zone being defined by an annular space above the suction-pressured space, the membrane sealing interior of the piston-cylinder unit below the membrane from exposure to the ambient outside the piston-cylinder unit and the membrane being dimensioned so as to allow reciprocation of the cylinder and the annular space being dimensioned so as to allow movement of the membrane therein as the piston reciprocates and the accommodate the membrane when the piston is at rest at end of a downstroke...”

None of these claimed features are present in Yoder.

In addition, Applicant’s hand held operating device differs from Yoder’s disclosure. Yoder discloses a wand including “a lumen in communication with the [high pressure] delivery tube, that terminates in one or more fine axial or transverse jet orifice(s)” (Col. 4, lines 57- 62.

Applicant claims **“a manipulable operating device including an internal pressure tubule terminating in the jet and a suction pipe sheathing the pressure tubule”**. The suction pipe is connected to an exhaust line which in turn is connected to a pump for sucking off liquid that was pushed through the pressure tubular into, for example, a wound area that is treated by the water jet. Tissue particles may be removed through the pressure tubule. There is no teaching of a dual tubular wand in Yoder.

Anticipation requires identity of invention. *See* MPEP 2131. *See also Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in

the claims. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). There must be no differences between what is claimed and what is disclosed in the prior art reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967.) Because Yoder's taught invention is not identical to Applicant's invention as claimed, Applicant submits that claims 8 and 11 are not anticipated by Yoder. Thus, Applicant requests to remove the rejection under 35 USC § 102.

### **Claim rejections under 35 USC § 103**

The Examiner rejected claims 9 as being unpatentable over Yoder et al. in view of Gernlein (US 4 234 107). Applicant submits that claim 9 is dependent on claim 8 and with claim 8 being amended, claim 9 was indirectly amended. Claim 9, in addition, includes that the lowermost portion of the annular space tapers inwardly in a downward direction toward the suction-pressured space, the taper being formed by a frustoconical portion of the cylinder wall.

The subject matter of claim 9 is not obvious over Yoder in view of Gernlein. Yoder, as discussed above discloses an entirely different pump system (a diaphragm pump insertable into a pump housing) than the one claimed by applicant and thus, it is not clear how the limitation of claim 9 (modifying the pump claimed on claim 8) is rendered obvious over Yoder and Gernlein. How does the Examiner contemplate the combination of the disclosure of Gernlein, who is showing a tapered annular space in a piston housing, into a non-piston pump arrangement, such as the one taught by Yoder? The combination would not provide the claimed invention of applicants claim 9. For those reasons, applicant submits that claim 9 is not obvious over the combination of Yoder and Gernlein, and thus, the rejection should be withdrawn.

Further, the Examiner rejected claim 10 as being unpatentable over Yoder et al. in view of Allen (US 3 622 251). Applicant submits that claim 10 is dependent on claim 8 and with claim 8 being amended, claim 10 was indirectly amended. Claim 10, in addition, includes that the cylinder casing and piston are constituted of plastic. The subject matter of claim 10 is not obvious over Yoder in view of Allen. Yoder, as discussed above, discloses an entirely different pump system (a diaphragm pump insertable into a pump housing) than the piston-cylinder casing claimed by applicant and thus, it is not clear how the limitation of claim 10 (describing the material of the

piston and cylinder) can be rendered obvious over a combination of a Yoder membrane/ pump housing and a plastic piston and cylinder body of Allen. The combination would not provide the claimed subject matter of claim 10. For those reasons, applicant submits that claim 10 is not obvious over the combination of Yoder and Allen, and thus, the rejection should be withdrawn.

Moreover, the Examiner rejected claim 12 as being unpatentable over Yoder et al. in view of Rogers (US 4 551 146). Applicant submits that claim 12 is dependent on claim 8 and with claim 8 being amended, claim 12 was indirectly amended. Claim 12, in addition, includes connecting devices for connecting pressure tubes to a suction - pressure space having certain features. The subject matter of claim 12 is not obvious over Yoder in view of Rogers. Yoder, as discussed above, discloses a diaphragm pump insertable into a pump housing and having certain simple quick connection adapters. Rodger teaches a dialysis connector, which are not at all meant to be functioning under any pressure. The Examiner cited to certain passages in Rodger, however, nowhere in such description does Rodger teach any pressure couplings. What Roger teaches instead are tube couplings which avoid contaminations and means for preventing contact with fingers or any other contamination means. The combination would not provide the claimed invention of applicants claim 12. For those reasons, applicant submits that claim 12 is not obvious over the combination of Yoder and Rogers, and thus, the rejection should be withdrawn.

The Examiner rejected claim 13 as being unpatentable over Yoder et al. in view of Rogers (US 4 551 146), in further view of Gernlein (US 4 234 107). Claim 13 is dependent on claim 12, which is dependent on claim 8, which was amended. Thus, claim 13 is indirectly amended. As discussed above, the primary reference of Yoder alone is distinguishable from Applicant's claimed invention and adding the several secondary references does not render claim 13 obvious. When a claim is properly rejected as obvious over a combination of references, it must also have been obvious to a person of ordinary skill to combine the references as suggested by the Examiner. However, claim 13 is different from the combinations of references in ways which would not have been obvious to make the combination. Dependent claim 13 is patentable for at least the reasons supporting the patentability of independent claim 1. Thus, the obviousness rejection should be removed. Applicant submits that claim 13 is patentable.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
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